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16 UNITED STATES DISTRICT COURT
17 NORTHERN DISTRICT OF CALIFORNIA
18

19 LUMILEDS LIGHTING U.S., LLC,

20 Plaintiff,

21 vs.

22 EPISTAR CORP., and UNITED
23 EPITAXY CO., LTD.,

24 Defendants.
25
26

Case No. C 05-04521 (MEJ)

**MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT OF
LUMILEDS LIGHTING U.S., LLC'S
ADMINISTRATIVE MOTION TO
CONSIDER WHETHER CASES SHOULD
BE RELATED PURSUANT TO CIVIL L.R.
3-12 AND 7-11**

Hearing Date/Time: Pursuant to Civil L.R. 7-
11(c), Motion is deemed submitted for
immediate determination without hearing on
December 16, 2005.

1 **I. INTRODUCTION**

2 Plaintiff Lumileds Lighting U.S., LLC, submits this memorandum in support of its
3 Administrative Motion to Consider Whether Cases Should be Related.

4 In the current complaint, Lumileds asserts infringement of three patents, including U.S.
5 Pat. No. 5,008,718 (“the ‘718 patent”), against United Epitaxy Co., Ltd. (“UEC”) and Epistar
6 Corp. Judge Claudia Wilken of the Northern District of California has previously presided over
7 three cases involving Lumileds and UEC and Epistar, all involving the ‘718 patent. Throughout
8 the more than 4½ years that these cases were pending before Judge Wilken, she issued more than
9 50 orders, including a Claim Construction Order for the ‘718 patent and an order ruling on
10 various summary judgment motions. Additionally, Judge Wilken has already ruled twice that
11 cases between Lumileds, UEC and Epistar involving issues of infringement of the ‘718 patent are
12 related within the meaning of the Local Rules. Thus, Lumileds respectfully requests that Judge
13 Wilken issue another Related Cases Order relating the present case to the previous three cases she
14 presided over since they involve the same parties, property, transactions, events, and questions of
15 law, and to prevent unduly burdensome duplication of labor and expense, and/or conflicting
16 results if the cases are conducted before different judges.¹

17 The present case is related to the following “Related Actions”: *United Epitaxy Co., Ltd. v.*
18 *Hewlett-Packard Co., et al.*, No. C 00-2518 CW (PVT) (N.D. Cal. filed Sept. 7, 1999) (Wilken,
19 J.) (“UEC Related Action”); *Lumileds Lighting U.S., LLC v. Citizen Electronics Co., Ltd., et al.*,
20 No. C 02-5077 JW (EAI) (N.D. Cal. filed Oct. 18, 2002) (Wilken, J.) (“Epistar I Related
21 Action”); and, *Epistar Corp. v. Lumileds Lighting US, LLC*, No. 03-CV-01130-CW (N.D. Ca.
22 transferred March 17, 2003 from C.D. Cal.) (Wilken, J.) (“Epistar II Related Action”).

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27 ¹ Since Lumileds believes that the present case should be assigned to Judge Wilken,
28 Lumileds is concurrently filing a declination to proceed before the assigned Magistrate Judge
Maria-Elena James.

II. THE PRESENT CASE INVOLVES THE SAME PARTIES AND SUBSTANTIALLY THE SAME PROPERTY, TRANSACTIONS, AND EVENTS AS THE RELATED ACTIONS.

The present case and the Related Actions are based on the same dispute over infringement by Epistar and UEC of Lumileds' patents, including infringement of the '718 patent, which is directed to novel high-brightness light-emitting diodes ("LEDs").² The Defendants, Epistar and UEC, announced on August 15, 2005 that they are planning on merging on December 30, 2005, with the surviving company to be named Epistar. *See* Wu Decl., ¶¶ 4-5, Exhs. C-D. Thus, there will soon be a single entity who is once again before this Court to address issues of infringement of Lumileds' '718 patent.

Furthermore, many of the same transactions and/or events involved in the present case were addressed in the Related Actions. For example, the construction of the claims of the '718 patent will be the same as it was in the Related Actions. Also, the licenses and settlement agreements from the Related actions will drastically limit the issues to be resolved, by eliminating any arguments that the '718 patent is invalid or unenforceable. Furthermore, all of the parties have conducted extensive discovery during the Related Actions about various transactions and events, and as such, many of the issues regarding these items have already been addressed by Judge Wilken.

For all of the these reasons as well as those stated in Lumileds' Notice of Related Action filed in the Epistar I Related Action (*See id.*, ¶ 6, Exh. E) and the Epistar II Related Action (*See id.*, ¶ 7, Exh. F), the present case should also be declared related.³

III. AN UNDULY BURDENSOME DUPLICATION OF LABOR AND EXPENSE OR CONFLICTING RESULTS ARE LIKELY TO OCCUR IF THE CASES ARE CONDUCTED BEFORE DIFFERENT JUDGES.

Assignment of the present case to Judge Wilken, who presided over all of the Related Actions, will conserve judicial resources and promote an efficient resolution of the dispute. Since

² The present case also involves two additional patents owned by Lumileds: U.S. Pat. Nos. 5,376,580 and 5,502,316, both are directed to novel high-brightness LEDs.

³ Lumileds was unable to obtain a stipulation from the Defendants. *See* Wu Decl., ¶¶ 2-3, Exhs. A-B.

1 the present case and the Related Actions are based on the same dispute (infringement of the ‘718
 2 patent), a single Judge should preside over all of the matters. Moreover, Judge Wilken has
 3 already invested significant time in resolving many of the legal and factual questions in the
 4 Related Actions that are likely to be at issue in the present case as well. For example, Judge
 5 Wilken’s extensive efforts during the approximate 4½ years pendency of the Related Actions are
 6 reflected in the more than 1,000 entries in the Court dockets, including numerous Orders issued
 7 by Judge Wilken: twenty-nine (29) orders in the UEC Related Action, forty-four (44) Orders in
 8 the Epistar I Related Action, and twenty-nine (29) Orders in the Epistar II Related Action. *See*
 9 *id.*, ¶¶ 8-10, Exhs. G-I.

10 In particular, Judge Wilken held a claim construction hearing on January 12, 2001 and
 11 issued a twenty-three page order on May 10, 2001 construing the claims of the ‘718 patent. *See*
 12 *id.*, ¶ 11, Exh. J. The claim construction issue was brought before Judge Wilken a second time in
 13 Epistar I Related Action, where Lumileds submitted a second brief on these issues and Epistar
 14 submitted its responsive brief, both with numerous supporting factual and expert declarations.
 15 Thus, Judge Wilken is not only familiar with the issues surrounding claim construction of the
 16 ‘718 patent, but she has already ruled on those issues.

17 Judge Wilken also granted summary judgment of (1) no indefiniteness, (2) no
 18 anticipation, and (3) no inequitable conduct. In particular, Judge Wilken conducted a hearing on
 19 May 11, 2001 on these summary judgment motions and issued an order on June 14, 2001 granting
 20 in part Lumileds’ motion for summary judgment and denying the Defendant’s cross-motion for
 21 summary judgment. *See id.*, ¶ 12, Exh. K. Thus, Judge Wilken is already familiar with many of
 22 the complex issues regarding infringement of the ‘718 patent; and, if a different Judge is assigned,
 23 then an unduly burdensome duplication of labor and expense or conflicting results are likely to
 24 occur.⁴

25 ⁴ Even Judge Audrey Collins of the Central District of California acknowledged that Judge
 26 Wilken was the proper judge to preside over a case between Epistar and Lumileds regarding
 27 infringement of the ‘718 patent – “The Court agrees with Defendant [Lumileds]. Because Judge
 28 Wilken has a case pending regarding the ‘718 patent, and because she has dealt with a case
 regarding the same patent, it would be a more efficient use of judicial resources to hear the case in
 the Northern District.” *See* Wu Decl., ¶ 13, Exh. L (Order Granting Defendant’s Motion to
 Transfer Venue in the Epistar II Related Action, at 8-9).

IV. JUDGE WILKEN HAS TWICE RULED THAT LUMILEDS' ASSERTION OF THE '718 PATENT AGAINST UEC AND EPISTAR ARE RELATED

Twice before, Judge Wilken has issued Related Case Orders regarding Lumileds' assertion of the '718 patent against the Defendants. First, on February 11, 2003, Judge Wilken ruled that the Epistar I Related Action was related to the UEC Related Action. *See* Wu Decl., ¶ 14, Exh. M. Then, on March 27, 2003, Judge Wilken ruled that the Epistar II Related Action was related to the UEC Related Action and the Epistar II Related Action. *See id.*, ¶ 15, Exh. N. As Judge Wilken's knowledge of and experience with the '718 patent and the parties grows, it makes more sense than ever for her to preside over another related action.

V. THE PRESENT ACTION IS RELATED TO THE PREVIOUS ACTIONS BEFORE JUDGE WILKEN IN THE NORTHERN DISTRICT OF CALIFORNIA

The present case and the Related Actions all concern the same parties (Lumileds, Epistar and UEC), the same property (the '718 patent), and the same transactions and/or events (*e.g.*, the inventions claimed in the '718 patent and the Defendants' infringement of the '718 patent). *See* Civil L.R. 3-12(a). There is also likely to be an unduly burdensome duplication of labor and expense by the parties and the Court in litigating the various issues involved in a patent infringement suit over the '718 patent if an Order Relating Cases is not issued. *See* Civil L.R. 3-12(b). Furthermore, if Judge Wilken is not assigned to the present case, it is likely that conflicting results could occur that relate to issues between the parties, including, but not limited to, the very definition of the property interest at issue, the construction of the '718 patent claims. *See id.*

VI. CONCLUSION

For all the foregoing reasons, Lumileds respectfully requests that this Court grants its Administrative Motion to Consider Whether Cases should be Related and that the present case be assigned to Judge Wilken.

Dated: December 12, 2005

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: /s/ Andrew J. Wu

Andrew J. Wu

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Lumileds Lighting U.S., LLC